

use. For reasons described below in greater detail, Applicants submit that Claims 19-36 should be examined together with the product claims.

Claims 48-55 are temporarily withdrawn from further consideration as being drawn to a non-elected species.

An election of species within claims 37-47 was required and has been made above.

A. Traversal of the Withdrawal of Claims 19-36

Citing 37 C.F.R. §1.142(b) and MPEP § 821.03, the Examiner asserts that claims 19-36 should be withdrawn as being directed to a constructively non-elected invention. Applicants respectfully traverse the withdrawal of Claims 19-36 and invoke 37 C.F.R. § 1.143 to ask that the Examiner reconsider this withdrawal. Most importantly, the Federal Circuit has indicated that whenever possible product and method of use claims should be examined together in chemical cases. Applicants further submit that, in view of the prosecution history of this and related cases, concurrent examination of product and method of use claims would not impose an unreasonable burden on the Examiner. These claims would be subjected to the same species election exercised in conjunction with the claims currently under consideration.

1. Product and method of use claims should be examined together

“In chemical cases, a compound and its properties are inseparable.” *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963); *In re Pleuddemann*, 910 F.2d 823, 827, 15 USPQ2d 1738, 1740 (Fed. Cir. 1990) (“*Pleuddemann*”). In *Pleuddemann*, the Federal Circuit specifically stated that:

...in our view it is in the public interest to permit appellant to claim the process [of use] as well as the product. The result is to encourage a more detailed disclosure of the specific methods of using the novel composition he had invented in order to have support for the process claims.

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. 112, all aspects of

what they regard as their inventions, regardless of the number of statutory classes involved.

The Applicants submit that the principal use of the motif-bearing peptides of the product claims is to induce a CTL response. Accordingly, under *Pleuddemann*, it is in the public interest to examine use claims 19-36 together with product claims. Thus, Applicants respectfully request reconsideration of the withdrawal of Claims 19-36.

2. Examination of Claims 19-36 together with product claims would not be unreasonably burdensome.

The main reason for withdrawing Claims 19-36 appears to be that they would place an additional examination burden on the Examiner. However, Applicants understand that in order to properly and thoroughly examine the product claims, the Examiner has searched and will search all publications and applications that allude to peptides having the claimed motifs. This search would necessarily encompass any references that use these peptides to induce CTL. Applicants understand that if the claimed products are patentable, then the uses of these novel products should also be patentable, and that in this circumstance examination of use claims should not represent an unreasonable burden.

It is possible for method of use claims to be patentable even if product claims were not. This possibility does not, however, create an unreasonable examination burden. This is particularly true in this case, because the Examiner has before him multiple applications relating to motif-bearing peptides and their use to induce CTL. While the particular motifs and products vary from application to application, a number of features to be considered during examination are often common throughout. Applicants respectfully submit that, in light of the Examiner's previous involvement in the prosecution of multiple related and unrelated applications and in light of his past and present examination of product claims in this case, any incremental effort required to examine the method claims at issue does not overcome the Federal Circuit's explicit guidance to concurrently examine product and use claims. If the Examiner should disagree, the Applicants would request that evidence be provided to demonstrate why *Pleuddemann* should be disregarded.

CONCLUSION

In view of the foregoing, Applicants submit that all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-273-7521.

Respectfully submitted,

Hector A. Alicea

Hector A. Alicea, J.D., Ph.D.
Reg. No. 40,891

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
HAA:lcb
161866 v1